

Serial No.: 10/601,324  
Filing Date: June 20, 2003

### **REMARKS/ARGUMENTS**

Reconsideration is respectfully requested. Claims 1, 2, 4, 9, 10, 12, 15, 17, 26, 27, and 30-38 are pending. Claims 26, 27, 30, 31, 32 and 33 are withdrawn. Claims 3, 5-8, 11, 13-14, 16, 18-25, 28-29 are canceled. Claims 1, 2, 9, 10, 35, 36 and 38 have been amended. No new matter has been added as a result of the amendments. Amendment to and cancellation of the claims does not affect inventorship.

Applicants thank the Examiner for the allowance of claims 17, 34 and 37.

Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

#### **Claim Amendments**

Claims 1, 2, 9, 10, 35, 36 and 38 are amended. Support is found in the specification, for example, in paragraphs [0086], [0094], and [0110]. The amendments do not affect the scope of the claims.

#### **Claim Objections**

Claims 2, 32, 35, 36 and 38 are objected to because of several informalities. Applicants have made the appropriate corrections and thus request withdrawal of the rejections with respect to these claims.

#### **Claim Rejection Under 35 U.S.C. § 112**

##### **Indefiniteness**

Claims 9, 31 and 36 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claim 31 has been withdrawn thereby rendering the rejection moot with respect to this claim. Claims 9 and 36 have been amended to clarify their scope. Support for this amendment can be found in paragraph [0086]. Hence, the Examiner is respectfully requested to withdraw the rejection with respect to claims 9 and 36.

Serial No.: 10/601,324  
Filing Date: June 20, 2003

Written Description and Enablement

Claims 1, 2, 4, 9, 10, 12, 15, 26, 27, 30-33, 35 and 36 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description and enablement requirements.

Applicants respectfully traverse as follows:

The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)). The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. See M.P.E.P. § 2163.02 (emphasis added).

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498.

Claims 26, 27 and 30-33 are withdrawn thereby rendering the rejection moot with respect to these claims.

Claims 2 and 10 have been amended to clarify their scope. Support for this amendment can be found in paragraph [0110]. Hence, the Examiner is respectfully requested to withdraw the rejection with respect to claims 2 and 10.

Serial No.: 10/601,324  
Filing Date: June 20, 2003

Claims 1 and 9 have been amended to recite that the protein crystal contains a complex of the protein with an ATP binding site ligand. Hence, the Examiner is respectfully requested to withdraw the rejection with respect to claims 1 and 9.

Claims 35 and 36 have also been amended to recite that the protein crystal contains a complex of the protein with an ATP binding site ligand. Claims 35 and 36 have also been amended to recite that the protein "comprises" residues 596-900 of SEQ ID NO:1. The Examiner states that claims 35 and 36 "also lack enablement and written description because no crystals were ever formed with just amino acids 596-900 of SEQ ID NO:1." Although the example recited in the specification is directed to the crystallization of the His-tagged version of the subject protein, Applicants have indicated that removal of the His-tag, while optional, is nevertheless possible by treatment with rTEV protease. SEQ ID NO: 3 in Fig. 1 "comprises" residues 596-900. Inasmuch as the specification provides a working example for the crystallization of protein set forth in SEQ ID NO:3, it supports the crystallization of a protein that comprises residues 596-900.

In view of the foregoing amendments and arguments, Applicants respectfully request the Examiner to withdraw the rejection of claims 1, 2, 4, 9, 10, 12, 15, 35 and 36.

Serial No.: 10/601,324  
Filing Date: June 20, 2003

**CONCLUSION**

In view of the foregoing amendments and arguments, it is believed that all claims now pending in this application are in condition for allowance. Should the Examiner not agree, the Applicant respectfully asks the Examiner to contact the undersigned at the phone number below to discuss any remaining issues and accelerate the examination and allowance of this application. Authorization is granted to charge any outstanding fees due at this time for the continued prosecution of this matter to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (Client Matter No. 067450-5008US01).

Respectfully submitted,

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On behalf of:  
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